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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,057	03/04/2002	Martin Hurich	10191/2276	6708

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EXAMINER	
PEIKARI, BEHZAD	

ART UNIT	PAPER NUMBER
2186	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/091,057	HURICH ET AL.	
	Examiner	Art Unit	
	B. James Peikari	2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) *7 and 8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 March 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-6 in the reply filed on October 1, 2004 is acknowledged.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on March 2, 2001. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

3. The listing of references in the specification (note page 2) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

4. The drawings are objected to because each of the boxes in Figures 1, 2 and 3 should be properly labeled within the drawing itself. Corrected drawing sheets in

compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The specification is objected to because the title is not clearly indicative of the invention to which the claims are directed. The following title is suggested to correspond to the present claims "METHOD FOR PROTECTING SOFTWARE PROGRAMS FROM INADVERTENT EXECUTION".

6. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the looking for the pattern at "one point in time" occurring *after* the "certain point in time" when the pattern is generated (note, for example, "one later time" in the Abstract), does not reasonably provide enablement for looking for the pattern at "one point in time" occurring *before* the "certain point in time" when the pattern is generated (such a preliminary check is neither taught nor efficient). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Memory elements do not generate data.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Inagaki, U.S. 6,421,773.

As for claims 1 and 6, a method of safeguarding at least one program part that is critical to safety against inadvertent execution, comprising executing the at least one program part in a predetermined chronological sequence (*all software programs run in a*

predetermined chronological sequence, adjusted by any input values, note column 1, line 6); at a certain point in time in the execution, generating a pattern (*note the patterns generated by test pattern generator 6*); at least one point in time checking whether the pattern is present (*note column 1, lines 23-51*); and terminating the execution of the program part if the pattern is determined not to be present (*note the time-out that occurs when an attempt to locate the pattern shows that the memory is defective*).

As for claim 2, generating a pattern at the beginning of the execution of the program (*note column 1, lines 27-28*)

As for claims 4 and 5, checking the state of a hardware component as an external boundary condition (*note Tinaztepe et al., column 1, lines 7-11*).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claim 3 is rejected under 35 U.S.C. 103 as being unpatentable over Inagaki, U.S. 6,421,773, in view of Tinaztepe et al., U.S. 5,913,022.

Although the role of the volatile memory element is unclear from claim 3 (see section 9 of this Office action), the use of volatile memory was not explicitly mentioned in the Inagaki system described above. However, Tinaztepe et al. also taught a system

for utilizing test patterns to prevent or control program flow to defective circuitry, as in the Inagaki system, and further taught the use of a volatile memory element (*note the random access memory of Tinaztepe et al., Figure 1*).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the volatile memory of Tinaztepe et al. in the system of Inagaki et al., since (a) such memory may have provided faster access to the test program than some non-volatile memory types, such as disk or tape, or even the flash memory of Inagaki, and (b) the Tinaztepe et al. system was specifically designed with the same function to to prevent or control program flow to defective circuitry, in a manner compatible with the Inagaki system.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In fact, although additional rejections have not been deemed necessary, the examiner has determined that the scope of the present independent claims permit them to be taught by *each* reference cited on the attached form PTO 892, which runs the gamut of circuit testers to sewing machines.

Consequently, applicant is encouraged to contact the examiner directly to discuss and determine whether any patentable subject matter exists within the disclosure of the invention.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Peikari whose telephone number is (571) 272-4185. The examiner is generally available between 7:00 am and 7:30 pm, EST, Monday through Wednesday, and between 5:30 am and 4:00 pm on Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (571) 272-4182.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2100 central hotline at (571) 272-2100.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 746-7239 (Official communications)

or:

(703) 746-7240 (for Informal or Draft communications)

or:

(703) 746-7238 (for After-Final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

B. James Peikari
Primary Examiner
Art Unit 2186

12/27/04